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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,617	10/20/2003	Katsuhiko Akiyama	1405.1077	2603

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EXAMINER	
SINGH, RACHNA	
ART UNIT	**PAPER NUMBER**
2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/687,617	AKIYAMA, KATSUHIKO	
	Examiner	Art Unit	
	Rachna Singh	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/06 has been entered.

2. Claims 1-7 are currently pending in the case, with claims 1, 6, and 7 being the independent claims.

3. Claims 1-7 are rejected.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-4, 6, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla, et al., (U.S. Patent 5,146,552, issued September 8, 1992) [hereinafter "Cassorla"], in view of Montlick, (U.S. Patent 5,561,446, issued October 1, 1996) [hereinafter "Montlick"].

Regarding **independent claim 1, as amended**, Cassorla in view of Montlick teaches:

A document browser that merges and displays additional information with document data, including text data and/or image data, that can be displayed on a display device, comprising:

an additional information input judgment means judging whether handwriting input is enabled at a location;

additional information receiving means for receiving input of the additional information that includes handwritten pen-track data;

(See, Cassorla, col. 2, lines 23-25, teaching that than annotation ("additional information") may be stored within or separately from the published material.)

browsing means for merging and displaying on the display device the document data with the additional information that includes handwritten pen-track data;

(See, Cassorla, col. 2, lines 31-35, teaching the display of the additional information with the original document data.)

positional information obtaining means for obtaining the positional information of the additional information in the document data;

(See, Cassorla, col. 2, lines 41-44, teaching the use of relative position to fix the precise position of some annotations that the reader wants to pinpoint to a particular line or word position.)

properties information obtaining means for obtaining properties information of the additional information;

(See, Cassorla, col. 4, lines 4-42, teaching a variety of properties that may be attached to annotations, including color, type style, etc.)

additional information storage means for storing the additional information that includes handwritten pen-track data with the positional information and the properties information;

(See, Cassorla, col. 5, lines 21-24, teaching storage of notes ("additional information") in a file or partition of a file on a host system or as a separate file on the local disk of a stand-alone workstation or personal computer.)

additional information searching means for searching the additional information stored in the additional information storage means based on the properties information of the additional information; and

(See, Cassorla, col. 9, lines 23-53, teaching search methods to recover additional information from memory storage locations and to associate that information with the appropriate text.)

search results display means for displaying on the display device the search results found by the additional information searching means.

(See, Cassorla, col. 9, lines 23-53, teaching search methods to recover additional information from memory storage locations and to associate that information with the appropriate text.

Cassorla does not expressly teach handwritten pen-track data.

Montlick teaches "handwritten pen-track data" as "electronic ink." Specifically, Montlick teaches receiving, displaying, and storing electronic ink as additional information to text and graphics. See, Montlick, col. 2, line 37 through col. 12, line 4, specifically see, col. 9, lines 26-37, and col. 10, line 6 through col. 11, line 18, teaching associating electronic ink with annotations. Further it is noted that in order to receive, display, and store the handwriting input, it is required that the input be "enabled"; otherwise handwriting input could not be input in the first place.

The teachings of Cassorla and Montlick are combinable in that that both involve the art of electronic annotation of text and graphics.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Cassorla and Montlick.

The suggestion or motivation to combine the references is that Cassorla teaches "notes" as textual annotations to a document. See, Cassorla, col. 4, line 55 through col. 5, line 30, teaching "notes" as annotations. Montlick teaches a handwritten, electronic ink, method of incorporating notes into an electronic document. Therefore Montlick merely adds another function, handwritten notes, to the typed notes taught by Cassorla. They are just different forms of entry for notes or annotations associated with a document.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick to result in the invention specified in claim 1.)

Regarding **dependent claim 2**, Cassorla in view of Montlick teaches:

The document browser according to claim 1, wherein the document data is an HTML document, an XML document, or other structured document.

(See, Cassorla, col. 1, lines 12-66, teaching that the invention may be used with a structured document, including a markup language source document, and also including a document in the standardized general markup language (SGML).)

Regarding **dependent claim 3, as amended**, Cassorla in view of Montlick teaches:

The document browser according to claim 1, wherein the properties information includes: attribute information included in the additional information including line color, level of transparency, and line thickness; or other properties data of the additional information such as a shape classification, size, or date and time of input.

(See, Cassorla, col. 5, lines 18-21, teaching that once the reader has completed adding the additional information, the invention adds the topic, line number, author identification, date and time information to the text of the note.)

Regarding **dependent claim 4**, Cassorla in view of Montlick teaches:

The document browser according to any of the claims 1, wherein the additional information receiving means comprises a pen tablet, a mouse, or other pointing device.

(See, Cassorla, col. 3, line 12 through col. 4, line 3, teaching use of an appropriate action with a pointing mechanism such as a text or graphic cursor driven by a mouse, touch screen, joystick, keyboard or other command action, which is the same as the means claimed in the application.)

Regarding **independent claim 6, as amended**, Cassorla in view of Montlick teaches:

A document browsing method in which additional information is merged and displayed with document data, including text data and/or image data, that can be displayed on a display device, comprising:

displaying the document data on a display device;

judging whether handwriting input is enabled at a location;

receiving an input of additional information, including handwritten pen-track data, with respect to the document data displayed on the display device;

merging and displaying on the display device the document data with the additional information that includes handwritten pen-track data;

obtaining the positional information of the additional information in the document data;

obtaining properties information of the additional information;

storing the additional information that includes handwritten pen-track data with the positional information and the properties information;

searching the additional information stored in the additional information storage means based on the properties information of the additional information; and

displaying on the display device the search results found by the additional information searching means.

(Claim 6 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **independent claim 7, as amended**, Cassorla in view of Montlick teaches:

A computer readable medium encoded with processing instructions for causing a processor to execute a document browsing method, the document browsing method merging and displaying additional information with document data, including text data and/or image data, that can be displayed on a display device, and comprising:

displaying the document data on a display device;

judging whether handwriting input is enabled at a location;

receiving the additional information, including handwritten pen-track data, input to the document data displayed on the display device;

merging and displaying on the display device the document data with the additional information that includes handwritten pen-track data;

obtaining the positional information of the additional information in the document data;

obtaining properties information of the additional information;

storing the additional information that includes handwritten pen-track data with the positional information and the properties information;

searching the additional information stored in the additional information storage means based on the properties information of the additional information; and

displaying on the display device the search results found by the additional information searching means.

(Claim 7 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

5. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla in view of Montlick as applied to claim 1 above, and further in view of Fitzpatrick, et al., "Translucent Window Attribute," IBM Technical Disclosure Bulletin, Vol. 36, No. 06A, pages 135-136, June 1, 1993 [hereinafter "Fitzpatrick"].

Regarding **dependent claim 5**, Cassorla in view of Montlick and further in view of Fitzpatrick teaches:

The document browser according to any of the claims 1, wherein the additional information is displayed semi-transparently so that the document data is identifiable when the additional information is merged with the document data.

(Cassorla in view of Montlick teaches the invention of claim 1, but does not expressly teach that the additional information is displayed semi-transparently so that the document data is identifiable when the additional information is merged with the document data.

Fitzpatrick expressly teaches a "translucent window," which is used when a container object is located on top of other container objects.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick for the association of annotations with a document, with the teachings of Fitzpatrick that a window containing the annotation could be placed on top of the text, with the annotation displayed semi-transparently or translucently.

The suggestion or motivation to combine the references is expressed in Fitzpatrick which states that the translucent window attribute greatly expands the number of objects accessible by users for a given presentation space. Rather than forcing a note to occupy a column of a display screen, overlaying a note over a document in a translucent form prevents obstruction of the underlying document and thus greatly expands the number of objects accessible to the user for a given presentation space.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick with the teachings of Fitzpatrick to result in the invention specified in claim 5.)

6. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Arguments

7. Applicant's further amendments and arguments filed 12/18/06 have been fully considered, but they are not persuasive.

Applicant argues the newly amended claim feature reciting "an additional information input judgment means judging whether handwriting input is enabled at a location" is not taught by Cassoria or Montlick either alone or in combination.

Examiner disagrees. Montlick expressly teaches "electronic ink," which is a commonly used term for "handwritten pen-track data." Montlick teaches "handwritten pen-track data" as "electronic ink." Specifically, Montlick teaches receiving, displaying, and storing electronic ink as additional information to text and graphics. See, Montlick, col. 2, line 37 through col. 12, line 4, specifically see, col. 9, lines 26-37, and col. 10, line 6 through col. 11, line 18, teaching associating electronic ink with annotations. In order to receive, display, and store the handwriting input, it is required that the input be "enabled"; otherwise handwriting input could not be input in the first place.

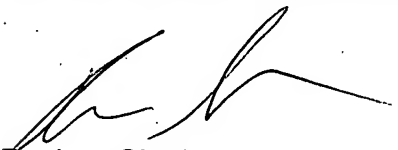
In view of the comments above, the rejection is maintained.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh whose telephone number is 571-272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rachna Singh
02/16/07